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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,681	05/22/2002	Kalevi Ratschunas	4925-219PUS	2735

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EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,681

Applicant(s)

RATSCHUNAS ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-12,14-17,20-23,35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-12,14-17,20-23, 35, and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 9, 11, 12, 14-17, 20, 21, 23, 35, 37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,119,014 by Alperovich in view of U.S. Patent No. 6,289,223 by Mukherjee et al, hereinafter Mukherjee.

Regarding claim 1, Alperovich discloses a method for delivering messages in a network (Figs. 1-4) comprising at least one terminal device (Fig. 4: 400, 480), comprising:
generating a message (e.g. SMS message; Fig. 4, 420) (col. 5, lines 27-30);
setting a condition (e.g. priority indication, location information) for receiving said message (col. 4, lines 7-12; col. 5, lines 27-35);
deciding whether said message is to be received by a terminal device based on said condition (e.g. if terminal device is in location area corresponding to the location information then send the message);
transmitting said message to said terminal device (Fig. 4, 400) based on deciding whether the message is to be received (e.g. whether the terminal device is in the location area) (col. 5, line 50 – col. 6, line 3);
deciding whether the originator of said message is permitted to receive a delivery report (e.g. failure report) (e.g. deciding whether the message was delivered); and

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transmitting said delivery report to the originator of said message only when said originator of said message is permitted the delivery report (e.g. when the message was not delivered) (col. 2, line 20 – col. 3, line 11);

Alperovich discloses transmitting a delivery report to an originator that is permitted to receive the delivery report. However, Alperovich does not disclose a list of originators of messages which are permitted to receive delivery reports is stored in a database.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises steps of generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37).

Wherein Mukherjee further discloses the step of deciding whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted (col. 6, lines 21-30) and the step of storing a list of originators of messages in a database which are permitted to receive delivery reports (col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich to include storing a list of originators of messages, which are permitted to receive delivery reports, in a database as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the

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originator of said message can receive a delivery report based on successful transmission and wherein multiple originators can send a message to a terminal device and those originators are recorded in a database to identify a valid sender of said received message who will receive a delivery report.

Regarding claim 2, the method according to claim 1, wherein Alperovich further discloses said setting step is performed by a terminal device (Fig. 4, 480) (col. 5, lines 27-35).

Regarding claim 3, the method according to claim 1, wherein Alperovich further discloses said condition is a location of said terminal device (col. 5, lines 27 – col. 6, line 3).

Regarding claim 4, the method according to claim 1, wherein Alperovich further discloses including information regarding said condition in an optional field (Fig. 4, 470) of said message (col. 5, lines 27 – col. 6, line 3).

Regarding claim 5, the method according to claim 1, wherein Alperovich further discloses determining said terminal device (Fig. 2, 200) as being inactive or busy when said condition is inherently not met (col. 2, line 20 – col. 3, line 11).

Regarding claim 8, the method according to claim 1, wherein Mukherjee further discloses defining a group of users which are allowed to receive delivery reports, wherein whether the originator of said received message is a member of said group of users is determined during said deciding step (col. 3, line 46 – col. 4, line 37; col. 6, lines 21-30).

Regarding claim 9, the method according to claim 8, wherein Mukherjee further discloses the step of adding a group identifier identifying said group of users to said message (col. 3, line 46 – col. 4, line 37).

Regarding claim 11, the method according to claim 1, wherein Alperovich further discloses said network is a mobile network (Figs. 1-4) and said terminal device is a mobile terminal device (Fig. 4: 400, 480) (col. 1, lines 25-45).

Regarding claim 12, Alperovich discloses a network system (Figs. 1-4) for delivering messages in a network, comprising:
a terminal device (Fig. 4, 400) comprising a judging means configured to determine whether a delivery report (e.g. failure report) (e.g. deciding whether the message was delivered) is to be transmitted in response to said message, a transmitting means configured to transmit said delivery report when said judging means determines that said delivery report is to be transmitted (e.g. when the message was not delivered) (col. 2, line 20 – col. 3, line 11); and
a message delivering device or SMS service center (Fig. 4, 460) comprising
a deciding means configured to decide whether a message is to be received by said terminal device based on a condition (e.g. priority indicator, location information) (col. 4, lines 7-12; col. 5, lines 27-35) for receiving said message (e.g. if terminal device is in location area corresponding to the location information then send the message), and
a transmitting means configured to transmit said message to said terminal device based on said deciding means determining whether the message is to be received (e.g. whether the terminal device is in the location area) (col. 5, line 50 – col. 6, line 3).

Alperovich discloses transmitting a delivery report in response to receiving a message. However, Alperovich does not disclose a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message and a database having a stored list of originators of messages, which are permitted to receive delivery reports.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises: generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37) .

Wherein Mukherjee further discloses the step of deciding (judging) whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted and said message is received (col. 6, lines 21-30) and the step of storing a list of originators of messages in a database which are permitted to receive delivery reports (col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Alperovich to include a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message and storing a list of originators of messages, which are permitted to receive delivery reports, in a database as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission of said message and wherein multiple originators can send a message to a terminal device and those originators are recorded in a database to identify a valid sender of said received message who will receive a delivery report.

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Regarding claim 14, please see the rejection to claims 1 and 2 above, to reject the system in claim 14.

Regarding claims 15-17 and 23, please see the rejections of claims 3-5 and 11 above, respectively, to reject the system in claims 15-17 and 23.

Regarding claims 20-21, please see the rejections of claims 8-9 mentioned above, respectively, to reject the system in claims 19-21.

Regarding claim 35, Alperovich discloses a terminal device (Fig. 4, 400) for receiving a message for which a condition (e.g. priority indicator, location information) for receiving said message is set for use in network (Figs. 1-4), comprising:

a receiving means configured to receive said message (col. 5, line 50 – col. 6, line 3);

a judging means configured to determine whether a delivery report (e.g. failure report) is to be transmitted in response to said message; and

a transmitting means configured to transmit said delivery report when said judging means determine that said delivery report is to be transmitted (col. 2, line 20 – col. 3, line 11).

Alperovich discloses transmitting a delivery report in response to receiving a message. However, Alperovich does not disclose a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message and a database having a stored list of originators of messages, which are permitted to receive delivery reports.

Mukherjee discloses a system and method for enabling an originating mobile unit to deliver SMS messages to a select plurality of destination mobile units (see Abstract). Wherein the method comprises: generating a message, setting a message, condition for receiving said message (if the originator is allowed to access a receiving subscriber or receiving group of

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subscribers), deciding whether said message is to be received by terminal device(s) on the basis of said condition, and transmitting said message to said terminal device on the basis of a result of the deciding step (col. 3, line 3 – col. 4, line 37) .

Wherein Mukherjee further discloses the step of deciding (judging) whether the originator of said message is permitted to receive a delivery report, and transmitting said delivery report to the originator of said message only in case said originator of said message is permitted and said message is received (col. 6, lines 21-30) and the step of storing a list of originators of messages in a database which are permitted to receive delivery reports (col. 6, lines 21-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the device Alperovich to include a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message and storing a list of originators of messages, which are permitted to receive delivery reports, in a database as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can receive a delivery report based on successful transmission of said message and wherein multiple originators can send a message to a terminal device and those originators are recorded in a database to identify a valid sender of said received message who will receive a delivery report.

Regarding claims 37 and 39, please see the rejections of claims 3 and 11 above, respectively, to reject the terminal device in claims 37 and 39.

3. Claims 10, 22, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alperovich in view of Mukherjee, as applied to claims 1, 12, 24, 29, and 35 above, respectively, and in further view of U.S. Patent No. 6,732,273 by Byers.

Regarding claim 10, the method according to claim 1, wherein Alperovich further discloses said message is a SMS message (col. 2, lines 12-18).

Alperovich in view of Mukherjee do not disclose said message is a multimedia message.

Byers discloses a method for delivering messages in a network (Fig. 1) comprising at least one terminal device (Fig. 1: 131, 134), comprising:
generating a message (col. 3, lines 40-46);
setting a condition (e.g. message characterizing code) for receiving said message (col. 3, line 46 – col. 4, line 20);
deciding whether said message is to be received by a terminal device (Fig. 1, 131) based on said condition (e.g. determining a predetermined subscriber selected threshold based on the message characterizing code); and
transmitting said message to said terminal device based on deciding whether the message is to be received (e.g. whether message meets certain predefined criteria) (col. 5, line 15 – col. 6, line 10).

Wherein Byers further discloses said message is a multimedia message (col. 2, lines 58-66).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the method of Alperovich in view of Mukherjee to include said message is a multimedia message as taught by Byers. One of ordinary skill in the art would have been lead to make such a modification since the originator of said message can send a multimedia message including: attachments, advertising, and audio/video clips to a terminal device.

Regarding claims 22 and 38, please see the rejection to claim 10 above, to reject claims 22 and 38.

Response to Arguments

4. Applicant's arguments, see Amendment, filed 4-5-2006, with respect to the rejection(s) of claim(s) 1-5, 8-12, 14-17, 20-23, 35, and 37-39 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. Please see all rejections above.

5. Regarding Applicant's arguments that Alperovich fails to disclose the following '...limiting sending the delivery report to only the originator of a message that is permitted to receive the delivery report...' and Mukherjee fails to teach '...the sending of delivery reports should or could even be restricted...'.

Examiner disagrees. Alperovich clearly discloses the delivery report (e.g. failure report) is sent only to the originator of the message to inform the originator that the message was not delivered and the reason why, in order for the originator to order retransmission later (col. 2, lines 19-27). Mukherjee clearly discloses the sending of delivery reports could be restricted only to the originating mobile station, in order to inform the originating mobile station of successful delivery of the message (col. 6, lines 21-29).

In conclusion, the prior art teaches the claimed invention. Please see all rejection(s) above.

6. Accordingly, this action is **FINAL**.

Conclusion

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 6,208,870 by Lorello et al discloses delivering messages in a network and transmitting a delivery report to the originator if requested

9. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

June 12, 2006


FAN TSANG
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TECHNOLOGY CENTER 2600